

REMARKS

STATUS OF CLAIMS:

Claims 1-18 and 21-25 have been pending.

Claims 1-16, 18 and 21-25 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Orikomio, in view of Kent, U.S. Patent Publication No. 2002/0040374 (hereinafter "Kent").

Claim 17 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Orikomio, in view of Kent, in further view of Fredrickson, U.S. Patent Publication No. 2002/0019768 (hereinafter "Fredrickson").

In accordance with the foregoing, the claims are amended, claims 2, 11 and 12 are cancelled without prejudice or disclaimer, and, thus, the pending claims remain for reconsideration, which is respectfully requested.

No new matter has been added.

The Examiner's rejections are respectfully traversed.

CLAIM REJECTIONS:

Independent claims 1, 18 and 21-25 are allegedly unpatentable over Orikomo in view of Kent.

Kent is newly cited and newly relied upon.

In accordance with the foregoing, claim 1 is amended to incorporate features from claims 2, 11 and 12, and recites, in part: "an advertisement preparation unit for preparing a second advertisement; an advertisement requested by an advertiser, publishing the prepared advertisement in a Web page for advertisement viewing, and preparing and publishing a non-contract use page including local area information other than said advertisement on said Web page to be provided as a privileged second service for subscription users to the first non-privileged service by placing said second advertisement on a privileged Web page; and an advertisement utilization unit which, when a user is identified as a subscription user to the first non-privileged service contract user based upon registered in the database through input user information, allows the subscription contract user to view said second advertisement on the non-contract use page privileged Web page so as to provide the privileged second service, and when a viewing request from a user identified as a non-contract user not registered in said database is received, prohibits publication of said advertisement on said non-contract use page and

publishes an application page for subscribing with said newspaper dealer.”

The Office Action, at page 5, line 17 to page 6, line 7, allegedly rejects claim 6, 10-11 and 16. However, the Office Action fails to address the language of claim 11. Specifically, claim 1, is amended to incorporate features of claim 11 and recites, in part, “an advertisement preparation unit for preparing a second advertisement, an advertisement requested by an advertiser, publishing the prepared advertisement in a Web page for advertisement viewing, and preparing and publishing a non-contract use page including local area information other than said advertisement on said Web page.” The Office Action fails to cite any reference against the claimed “preparing and publishing a non-contract use page including local area information other than said advertisement on said Web page.” Applicants respectfully submit that the Office Action fails to comply with the completeness requirements under 37 C.F.R. §1.104(b), by failing to “be complete as to all matters.” Accordingly, Applicants understand that either claim 11 is allowable or not properly rejected and respectfully request that a new, non-final, and complete Office Action be issued, if necessary.

Furthermore, the Office Action, at page 7, lines 4-13, rejects claim 12, asserting: “Orikomo does not explicitly teach, upon receipt of a visting request from a non-contract user not registered in the database, said advertisement utilization unit presents an application page for newspaper subscription contract, it is taught in Kent (see [0038], [0043], [0044]),” so the Office Action relies upon Kent.

The Office Action further asserts: “Kent teaches subscribers viewing second advertisement (the advertisement on the online newspaper) (see [0009] – [0014]).” However, Kent at paragraph 9, for example, recites:

The method of the present invention comprises a new publication process that employs the efficiency of the Internet and digital printing to create significant efficiencies for magazines, newspapers, other mass publications, and **customized printed products while better serving the individualized needs of consumers and advertisers.** The Internet allows users to interactively customize and personalize printed material with their personal content and advertising preferences. Digital printing allows publishers to economically print a customized publication for a specific customer. **The efficiency of digital printing combined with the flexibility of the Internet allows users to customize and personalize preferences and permits advertisers to effectively target consumers on a relevant and one-to-one basis.**

Further, Kent at paragraph 14, recites, for example:

A further advantage of the present invention is that it may help to reduce the publisher's distribution and postage costs. **The increase in efficiency achieved by reducing irrelevant content and advertising reduces the number of pages required to maintain a constant price/value ratio for the consumer. This reduction in weight can reduce postage and distribution costs.**

In other words, Kent discusses a user customized **printed publication**. Kent, at paragraph 10 further discusses:

With the process of the present invention, **consumers can customize and personalize magazines, newspapers, and other printed products they receive** or order to incorporate the layout (e.g., size of print) type of content, genres of information, and the category **and types of advertising that match their needs and requirements via a wizard or interactive set of questions on the publisher's website**. The information received from consumers about their preferences is distributed to publishers with digital printers (or to third-party print houses) that format and personalize magazines, newspapers, and other publications to meet the needs of their subscribers, thereby resulting in increased circulation and reduced loss of subscribers. Additionally, advertisers can more effectively target potential users of their products on an opt-in basis via subscriber response on the website and via predictive software based upon online and offline consumer databases.

In other words, Kent discusses that the user can customize a **printed publication** and customize the type of advertising that will appear in the customized printed publication.

Furthermore, Kent, at paragraph 38, recites:

As shown in FIG. 2, **the first step that a new consumer must usually take after establishing communication with the publisher's server 13, is to provide information about herself that the publisher can use to produce the magazine**. The first major set of information that the user will tender is personal information, as represented by personal information screen 60. Once the user has entered appropriate information, he will then view the next in a series of screens that comprise the personal information menu. Although it may be possible to place the entire personal information menu on a single screen, it is envisioned that the amount and variety of personal information will dictate that the user review a series of screens in order to fully input all of the personal information necessary. After all of the necessary personal information is input, the user needs to go through a series of content-related menu pages (screens) to select appropriate content for the magazine.

In other words, Kent discusses a customized publication in which a user must provide personal information so the publisher can produce a magazine for the user. Furthermore, Kent at paragraphs 43 and 44 recites:

Turning now to FIG. 3, **the personal information 60 category is expanded to illustrate the various types of personal information that the publisher may wish to acquire from the subscriber.** The first type of information is identification information about the subscriber, such as name, address, e-mail address, phone number, etc. The second block 90 contains identification information. The third block 94 of information comprises economic and demographic information 94. **This information is useful to the publisher both to help the publisher better understand the demographic cross section of her readers, and thus better help attract advertisers; and also better enable the publisher to select appropriate advertisements and content to integrate into the content of the publication.** For example, the publisher may not wish to include advertisements for expensive luxury cars to subscribers with poverty line income levels.

[0044] **The fourth block of information 96 comprises personal interest information. Obtaining personal interest information from subscribers also better helps the publisher to select advertising and content that is better to the interest of the subscribers.** Additionally, having this information makes the subscriber list that the publisher accumulates from all of the various subscribers more attractive to direct mail houses, charities, and other organizations that engage in target marketing. For example, if a substantial number of the subscribers indicated on the personal information block 96 that they enjoyed photography, the publisher may be able to mine this information from his subscriber database, to prepare a mailing list that would be valuable to camera and film companies, as the persons on the list would already have expressed a desire to engage in photographic pursuits

In other words, Kent, at paragraphs 43-44, discuss that personal information of the user is gathered so that the publisher can produce a magazine for the user based on the personal information.

Accordingly, Applicants respectfully submit that Kent fails to disclose, either expressly or implicitly, the claimed "when a viewing request from a user identified as a non-contract user not registered in said database is received, prohibits publication of said advertisement on said non-contract use page and publishes an application page for subscribing with said newspaper dealer," as recited in claim 1, because Kent merely discusses gathering personal information from which the content of a magazine is customized for the user.

Furthermore, the Office Action, in rejecting claim 2 at page 3, lines 19-21, asserts: "Regarding claims 2, 22-25, Orikomio teaches a contractor database that registers subscription users that have a subscription contract with a newspaper dealer to deliver a newspaper to the subscription user." Orikomio is, however, discussed in the present application at page 2, line 21 to page 3, line 11. Applicants respectfully disagree with the Examiner's characterization of the present application, because the application specification, at page 3, lines 3-11, recites: "In this system, advertisements and recruitment information that have been registered by advertisers such as retail outlets with the payment of advertising fees are placed on the Web pages for three days so that **general users and registered** users are allowed to view desired pages for free of charge, and this system is expected as an advertising system of the local area contacting type." In other words, the application discusses that registered users of the Orikomio website and non-registered users of the Orikomio website can view advertisements for free. Accordingly, Applicants respectfully submit that Orikomio fails to disclose, either expressly or implicitly, the claimed "a database which registers ... users having a subscriber contract with a newspaper dealer" and "prohibits publication of said advertisement on said non-contract use page" as recited in claim 1, because Orikomio merely discusses that both registered and unregistered users of the Orikomio website can view advertisements on the Orikomio website.

Accordingly, Applicants respectfully submit that a *prima facie* case of obviousness cannot be based upon Orikomio and Kent, because there is no evidence one skilled in the art would combine Orikomio's registered and non-registered user's viewing advertisements with Kent's customized publication, and then modified Orikomio, Kent or any combination of Orikomio and Kent to include the claimed "a database which registers ~~a supplier providing a first non-privileged service, said first non-privileged service being offered to users with and without a subscription for the first non-privileged service and said first non-privileged service having a first advertisement, and said database registers the users that have a subscription with the supplier for the first non-privileged service~~contract users having a subscriber contract with a newspaper dealer; an advertisement preparation unit ~~for preparing a second advertisement, an advertisement requested by an advertiser, publishing the prepared advertisement in a Web page for advertisement viewing, and preparing and publishing a non-contract use page including local area information other than said advertisement on said Web page to be provided as a privileged second service for subscription users to the first non-privileged service by placing said second advertisement on a privileged Web page~~; and an advertisement utilization unit which, when a user is identified as a ~~subscription user to the first non-privileged service~~contract user based upon registered in the database through input user information, allows the ~~subscription contract~~

user to view said ~~second-advertisement on the non-contract use page~~~~privileged Web page so as to provide the privileged second service, and when a viewing request from a user identified as a non-contract user not registered in said database is received, prohibits publication of said advertisement on said non-contract use page and publishes an application page for subscribing with said newspaper dealer,~~" as recited in claim 1, and seen a benefit of, for example, allowing a newspaper subscriber to view advertisements online.

Applicants respectfully submit that claims 18 and 21-25 patentably distinguish over the cited references for similar reasons as independent claim 1.

Dependent claims recite patentably distinguishing features of their own or are at least patentably distinguishing due to their dependence from the independent claims. Withdrawal of the rejection of pending claims, and allowance of pending claims is respectfully requested.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.


Respectfully submitted,

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